

## REMARKS

### Election/Restriction

Applicants acknowledge Examiner's restriction of the claims, Applicants reassert their election with traverse.

### Claim Objections

Applicants have addressed Examiner's objection to claims 2 and 8 as being substantial duplicatives of each other by canceling claim 2 and amending claim 8.

### Claim Rejections Under 35 U.S.C. § 112

Applicants have addressed the rejections of claims 1, 3, 9 and 12-14 under section 112. Claims 3, 9 and 12-14 have been canceled. Applicants have amended claim 1 and respectfully assert that Currently Amended claim 1 is in allowable form.

### Claim Rejection Under 35 U.S.C. § 102

Applicants have addressed Examiner's assertion that claims 1-3, 8 and 12-14 are anticipated by Heim et al. (Plant Pysiol., 1990 Vo. 92, 858-861). As noted above claims 2,3, 9 and 12-17 have been canceled, however, Applicants respectfully disagree with Examiner's assertion that amended claims 1 and 8 are anticipated by Heim.

Heim fails to teach or even suggest the limitation of a mutant herbicide resistant gene having the nucleotide sequence of SEQ ID NO: 1, as claimed by Applicants Amended claim 1. Examiner suggests that since Heim discloses a gene locus that confers resistance to the herbicide isoxaben, that the mutant gene disclosed by Heim inherently has the same sequence as SEQ ID NO: 1. However, MPEP §2112 states that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic (In re Rijckaert, 9 F.3d 1531). The fact that Heim discloses an isoxaben resistance gene does not suggest that Heim's gene necessarily has the same

sequence as SEQ ID NO: 1. Heim's gene could have a different sequence that conferred the resistance.

Heim fails to teach or even suggest the limitation of a mutant herbicide resistant gene having the nucleotide sequence of SEQ ID NO: 4, as claimed by Applicants' amended claim 8. Examiner suggests that since Heim discloses a gene locus that confers resistance to the herbicide isoxaben, that the mutant gene disclosed by Heim inherently has the same sequence as SEQ ID NO: 4. However, MPEP §2112 states that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic (In re Rijckaert, 9 F.3d 1531). The fact that Heim discloses an isoxaben resistance gene does not suggest that Heim's gene necessarily has the same sequence as SEQ ID NO: 4. Heim's gene could have a different sequence that conferred the resistance. Furthermore, Heim's gene could not have the same sequence as both SEQ ID NO: 1 and SEQ ID NO: 4.

For the forgoing reasons, Applicant respectfully requests that the Examiner allow Claims 1 and 8; Claims 2, 3, 9 and 12-17 have been canceled, Claims 4-7, 10, and 11 have been withdrawn.

Respectfully submitted,

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